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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,792	05/18/2006	Fabrizio Lori	LORI3002	3981
23364 7590 04/15/2009 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314-1176				
EXAMINER				
HUDA, SAIED M				
ART UNIT		PAPER NUMBER		
1791				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,792

Applicant(s)

LORI ET AL.

Examiner

SAEED M. HUDA

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-29 is/are pending in the application.
- 4a) Of the above claim(s) 28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Response to Amendment

1. The response filed on 03/18/2009 has been fully considered and entered into the record. The Examiner confirms applicant's election of group I (claims 19-27) and withdrawal of claims 28-29. The objections to claims 19-27 are withdrawn due to appropriate correction by applicant.

Response to Arguments

2. Applicant's arguments filed 03/18/2009 have been fully considered but they are not persuasive.

The Examiner acknowledges that Applicants' Admitted Prior Art (APA) and Bartetello are one in the same, but has kept them separate in the rejection to indicated where The Examiner located the prior art.

Applicant states that claim 19 has been amended to exclude from the extruded mixture any component which would change a fundamental characteristic of the mixture specifically ethylene-vinyl acetate (EVA); however, Brady states that other elastomers may be used such as vulcanized natural rubber, ethylene alpha olefin rubber, ethylene alpha olefin diene monomer rubber, styrene-isoprene-styrene, styrene butadiene styrene, styrene-ethylene-butylene-styrene, among others (column 8, lines 55-65).

Applicant goes on to state that Applicant believes that the mixtures containing EVA are not suitable for film articles for use in contact with the human body and that exclusion of EVA provides and improvement in air permeability; however, provides no support for this.

The Sheath reference is provided to show that the percentage of filler and elastomer used will affect the mechanical properties of the film, and thus, the amount of filler is a result effective variable.

Applicant states that the Kondo reference is provided for its teaching of use of a release film, which, allegedly, has no relevance to the deficiency of the basic reference combination. Claims 20 and 22-25 give requirements that relate to a breathable elastic film is covered with a separating material and the film cover is wound with the separating material into a roll. Kondo is used to address this claim limitation.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (APA) in view of Brady et al. (US 6258308 B1) further in view of Bortoletto (WO 01/32394 A1).

APA teaches that a polyolefin film to be stretched is obtained from a process which includes the steps of: producing a tubular element by blow extrusion molding, squeezing the tubular element to obtain two superimposed layers, heating the two superimposed layers to the softening point, pressing the two layers together to strongly joining them and cooling the film thus obtained ([0001]-[0005]). And the film is later

formed by transversely and/or longitudinally stretching the polyolefin film. APA fails to teach that the blow extruded material is a mixture of styrenic thermoplastic elastomer and filler or that the flat film is cooled to a temperature of 8°C-30°C (page 4).

Brady et al. teach a process for forming a film comprises a polyolefin and a filler (column 3, lines 21-26) and said film has breathability (abstract and column 3, lines 60-66). Brady et al. goes on to teach that a second polymer composition may be styrenic block copolymer (column 3, lines 35-40) and said copolymer may be styrene-isoprene-styrene, styrene-butadiene-styrene, or styrene-ethylene-butylene-styrene (claim 8). It would have been obvious to one skilled in the art at the time of the invention to include a styrenic thermoplastic elastomer and use a filler in the invention of EP-B1-1 226 013 because both are known components used to form a breathable polyolefin film as exhibited by the teachings of Brady et al.

Bortoletto teaches a method for producing a polyolefinic transpiring film by means of flattening an extruded tubular in order to obtain a flat film and transversal and/or longitudinal stretching of the flat film (abstract). Bortoletto goes on to teach that subsequent to heating and forming that the film is cooled to a temperature between 8°C - 30°C. It would have been obvious to one skilled in the art at the time of the invent to use this cooling temperature in the invention of APA because such is an art recognized cooling temperature range for flat films as exemplified by the teachings of Bortoletto.

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable applicant's admitted prior art (APA) in view of Brady et al. (US 6258308 B1) further in view of

Bortoletto (WO 01/32394 A1) as applied to claim 19 above, and further in view of Sheth (US 4777073).

The modified invention of EP-B1-1 226 013 fails to explicitly teach the claimed percentages. It is known in the film processing art that the percentage of filler and elastomer used will affect the mechanical properties of the film. Specifically, Sheth teaches a process for preparing a breathable film from polyolefin where the amount of filler added to the polyolefin affects its properties such as tear strength, water vapor transmission rate, and stretchability (column 2, lines 50-58). Absent evidence of unexpected results obtained from the claimed percentages used to make the film, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected a suitable mixture percentages to effectively optimize the mechanical properties of the film, the mixture percentages being a result effective variable routinely optimized by those of skill in the art. The optimization of a range or other variable within the claims that flows from the "normal desire of scientists or artisans to improve upon what is already generally known" is *prima facie* obvious. *In re Peterson*, 315 F.3d 1325, 1330 (Fed. Cir. 2003) (determining where in a disclosed set of percentage ranges the optimum combination of percentages lies is *prima facie* obvious). The discovery of an optimum value of a variable in a known process is usually obvious. *In re Aller*, 220 F.2d 454, 456 (C.C.P.A. 1955). See also *In re Boesch*, 617 F.2d 272, 276 (C.C.P.A. 1980) ("[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art."). See also *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997) ("[I]t is not inventive to discover the optimum or workable

ranges by routine experimentation.” (quoting *Aller*, 220 F.2d at 456)); *In re Kulling*, 897 F.2d 1147, 1149 (Fed. Cir. 1990) (finding no clear error in Board of Patent Appeals and Interferences’ conclusion that the amount of eluent to be used in a washing sequence was a matter of routine optimization known in the pertinent prior art and therefore obvious).

6. Claims 20 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art (APA) in view of Brady et al. (US 6258308 B1) and Bortoletto (WO 01/32394 A1) as applied to claim 19 above, and further in view of Kondo et al. (US 2003/0157338 A1).

- a. Regarding claims 20 and 22-24, the modified invention of EP-B1-1 226 013 fails to explicitly teach that the step of using separating material or winding the film onto a roll; however, Kondo et al. teach that film material may be stored as a roll and a release film (separating material) may be included ([0065]). Kondo et al. teach that films are prepared from paper or cloth (fabric) and that said release film is attached to the product via adhesive ([0066]). It would naturally flow from the description of the release film ([0066]) that it is continuous. It would have been obvious to one skilled in the art at the time of the invention to roll the film of EP-B1-1 226 013 and to use a release film during rolling, as disclosed in Kondo et al. because rolling is a space saving method of storing film and using a release layer prevent the film from sticking to itself.
- b. Regarding claim 25, the modified invention of EP-B1-1 226 013 makes no explicit disclosure that the coupling is performed without adhesive; however, it

would have been obvious to one skilled in the art at the time of the invention to do so because adhesives attached release films may be difficult to remove from the product, as acknowledged in Kondo et al. ([0051]), which can lead to damage of the product during attempt at removal of the release layer.

7. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art (APA) in view of Brady et al. (US 6258308 B1), Bortoletto (WO 01/32394 A1), and Kondo et al. (US 2003/0157338 A1) as applied to claim 20 above, and further in view of Board Jr. (US 4006051).

The modified invention of over EP-B1-1 226 013 fails to teach the use of a separating material in the form of a powder. Board Jr. disclose a laminate liner (abstract) and teaches that bearing liners have been prepared employing a facing surface composed of low friction suspended or powdered polymeric particles in a resin binder (column 1, lines 51-55). It would have been obvious to one skilled in the art at the time of the invention to use the powdered polymeric particles as a separating material because this is an art recognized material used for this application as exemplified by the teaching of Board Jr. Additionally, the Examiner directs Applicant to powdered latex gloves where the powder acts as a separating material. Thus, discontinuous, powdered separating materials are not novel.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAEED M. HUDA whose telephone number is (571)270-5514. The examiner can normally be reached on 8:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SAEED M. HUDA/
Examiner, Art Unit 1791

/Eric Hug/
Primary Examiner, Art Unit 1791